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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,016	01/23/2001	Stanley B. Miller III	500	9290
7590	06/02/2004		EXAMINER	
Joseph P. Gastel Suite 722 295 Main Street Buffalo, NY 14203-2507				TRAN, SUSAN T
		ART UNIT	PAPER NUMBER	1615

DATE MAILED: 06/02/2004

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 15

Application Number: 09/768,016  
Filing Date: January 23, 2001  
Appellants: MILLER ET AL.

**MAILED**  
**JUN 02 2004**  
**GROUP**

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Joseph P. Gastel  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the supplemental appeal brief filed 03/22/04.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences that will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 3, 38 and 39 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claims 7 and 28 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

The appellant has withdrawn claims 47 and 48 from appeal.

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

4,395,347	McLaughlin et al.	07-1983
4,855,276	Osborne et al.	08-1989
5,037,412	Tanzer et al.	08-1991
6,146,446	Tuma et al.	11-2000

**(10) Grounds of Rejection**

The following grounds of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6 and 38-46 rejected under 35 U.S.C. 103(a) as being unpatentable over Tuma et al. US 6,146,446.

Tuma teaches shaped adsorbent articles useful in electronic device (see abstract). The article comprising mixtures of adsorbent materials includes activated carbon, silica gel, calcium carbonate, potassium carbonate, potassium permanganate, calcium sulfate, and sodium carbonate; and binder includes microcrystalline cellulose, starch, sodium silicate, and polyvinylpyrrolidone (columns 5-6). The adsorbent article can be formed using compression molding or tablet-forming method (id, column 9, lines

47-62). Tuma does not teach first acid salt being primarily associated with the adsorbent, and second acid salt being primarily associated with the binder. However, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Thus, it would have been obvious for one of ordinary skill in the art to, by routine experimentation determine a suitable method with the expectation of at least similar result, because Tuma teaches an adsorbent article for the same purpose desired by the applicant, e.g., adsorbent article used in electronic devices to adsorb acid gas.

Claims 3-6 and 38-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuma et al. US 6,146,446, and McLaughlin et al. US 4,395,347.

Tuma is relied upon for the reason stated above. Although Tuma is relied upon for the teaching of mixture of materials, such as activated carbon, silica gel, calcium carbonate, potassium carbonate, sodium carbonate, Tuma is silent as to the teaching of mixture of the basic salts.

McLaughlin teaches blends of inorganic salts, including carbonates and bicarbonates basic salts are useful in absorbing the liquid components (column 2, lines 48-65). Thus, it would have been obvious for one of ordinary skill in the art to, by

routine experiment modify the absorbent article of Tuma using the mixture of basic salts taught by Osborne, because the references teach that mixture of basic salts can be used to absorb liquid components.

Claims 3-6 and 38-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuma et al. US 6,146,446, and Tanzer et al. US 5,037,412.

Tuma is relied upon for the reason stated above. Although Tuma is relied upon for the teaching of mixture of materials, such as activated carbon, silica gel, calcium carbonate, potassium carbonate, sodium carbonate, Tuma is silent as to the teaching of mixture of the basic salts.

Tanzer teaches an absorbent article comprising mixture of basic salt, including carbonates and bicarbonates (column 5, lines 25-32). Thus, it would have been obvious for one of ordinary skill in the art to, by routine experiment modify the absorbent article of Tuma using the mixture of basic salts taught by Tanzer, because the references teach that mixture of basic salts is useful in absorbent article.

Claims 7, 10-12 and 28-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuma et al. US 6,146,446, and Osborne et al. US 4,855,276.

Tuma is relied upon for the reasons stated above. Tuma is silent as to the limitation of second basic salt is associated with the binder. However, it is the position of the examiner that one of ordinary skill in the art would by routine experimentation determine a suitable process with the expectation of at least similar result, because

Tuma teaches the use of adsorbent article containing the same material, same shape, and for the same purpose, absorbing acid gas to protect electronic devices from contaminants.

Tuma is silent as to the teaching of sodium or potassium bicarbonate.

Osborne teaches adsorbent composition comprising activated carbon powder, activated alumina, water, and sodium bicarbonate (columns 5-6). Thus, it would have been *prima facie* obvious for one of ordinary skill in the art to prepare Tuma's adsorbent article using basic salts taught by Osborne, because the references suggest the use of basic salts in adsorbent composition to filter fluid, such as air within electronic devices. The expected result would be an adsorbent article in a variety of shapes useful to be placed in smaller spaces, such as disk drives.

### ***Claims Allowable***

Claims 19-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Appellant argues that Tuma does not teach the limitations of a "first basic salt being primarily associated with said adsorbent, and said second basic salt being primarily associated with said binder". However, it appears that appellant's specification does not define the terms "first basic salt primary associated" and "second basic salt

primary associated". Accordingly, Examiner is permitted to give any reasonable definition to these terms. A review of the specification at page 5, lines 6-10; page 6, lines 24-32; page 7, lines 1-2, indicate that a reasonable interpretation of the terms is that appellant intends to suggest mixing of the first and second basic salt with the adsorbent and binder respectively, altogether. Tuma mixes the claimed ingredients with the suggestion that the ingredients are used for the same purpose, e.g., shaped adsorbent articles used in electronic devices for absorbing acid gas, filtering fluid and air (see abstract, columns 1 and 9). Thus, it would have been obvious to use more than one basic salts for the same purpose, shaped adsorbent articles used in electronic devices for absorbing acid gas, filtering fluid and air, as done by appellant.

Applicant argues that it would not have been obvious for one of ordinary skill in the art to modify Tuma's adsorbent article to produce the composition wherein a first basic salt being primarily associated with the adsorbent, and said second basic salt being primarily associated with the binder. In response to applicant's argument, it is the product per se is being claimed, and the burden is shifted to appellant to establish that the mixing steps to produce an article taught by Tuma, imparts a patentably distinct article. The prior art articles are clearly shaped adsorbent articles useful for the same purpose, e.g., absorbing acid gas, filtering fluid and air. There are no ratios and/or percentages set forth that impart a distinction over the process disclosed by the prior art. Note that claim 34 clearly acknowledges that any proportions may be used. Furthermore, no unexpected result is seen in the use of multiple basics salts over the prior art teachings.

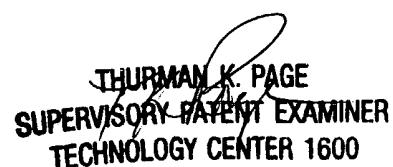
While the generic claims claimed the particular limitation, dependent claims 4, 5, 10, 11, 29, 32, 35, 41, 42, 44, and 45 recited first and second basic salts can be selected from the same salt groups, such as, sodium and potassium carbonates or bicarbonates. Although there are dependent claims that recited first acid salt is selected from the carbonates salt group, and second acid salt is selected from the bicarbonates salt group, applicant's specification at page 5 disclosed potassium carbonate or any other suitable basic salt (first basic salt) may be used with the binder. Accordingly, no criticality is seen in the limitation of first basic salt is associated with the adsorbent, and second basic salt is associated with the binder.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

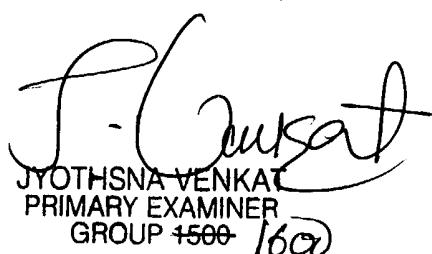


S. Tran  
May 20, 2004



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